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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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Lisco  
Serial No.: 10/672,136  
Filed: September 26, 2003 Customer No.: 28863  
Examiner: Janice A. Mooneyham  
Group Art Unit: 3629  
Docket No.: 1018-001US03  
Title: INTEGRATED ELECTRONIC MARKETPLACE AND ONLINE DISPUTE  
RESOLUTION SYSTEM

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By: 

Name: Karen Sorensen

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Commissioner for Patents  
Alexandria, VA 22313-1450

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**PATENT**  
**Docket No.: 1018-001US01**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Application of:

Lalitha Vaidyanathan et al.

Serial No.: 10/672,136

Art Unit: 3629

Filed: September 26, 2003

Examiner: Janice A.  
Mooneyham

For: INTEGRATED ELECTRONIC  
MARKETPLACE AND ONLINE DISPUTE  
RESOLUTION SYSTEM

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By:

  
Karen Sorensen

**APPEAL BRIEF**

Board of Patent Appeals and Interferences  
Commissioner for Patents  
P.O. Box 1450,  
Alexandria, VA 22313

Dear Sir:

This is an Appeal Brief from the Office Action mailed February 16, 2006. The Notice of Appeal was filed on April 13, 2006. The present application has been rejected more than twice. Appellant submits this Appeal Brief in triplicate. The small entity fee of \$250.00 for filing a brief in support of an appeal is enclosed.

Appellant requests the opportunity for a personal appearance before the Board of Patent Appeals and Interferences to argue the issues of this appeal. The fee for the personal appearance will be timely paid upon receipt of the Examiner's Answer.

Please also charge any additional fees that may be required or credit any overpayment to Deposit Account No. 50-1778.

## TABLE OF CONTENTS

	<u>Page</u>
Real Party in Interest.....	3
Related Appeals and Interferences.....	3
Status of Claims.....	3
Status of Amendments.....	3
Summary of the Claimed Subject Matter .....	4
Grounds of Rejection to be Reviewed on Appeal .....	8
Arguments of Appellant.....	9
Appendix: Claims on Appeal.....	36

### **REAL PARTY IN INTEREST**

The real party in interest is SquareTrade, Inc. of San Francisco, California.

### **RELATED APPEALS AND INTERFERENCES**

There are no related appeals or interferences.

### **STATUS OF CLAIMS**

Claims 49-73 are on appeal in this case.

Claims 49-73 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Claims 49-61 and 64-73 stand rejected under 35 U.S.C. 102(e) as being anticipated by Collins et al. (U.S. Publication No. 2002/0007362).

Claims 62 and 63 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Collins.

### **STATUS OF AMENDMENTS**

No amendments have been filed subsequent to the Rejection mailed February 16, 2006 from which this Appeal has been made.

## SUMMARY OF THE CLAIMED SUBJECT MATTER

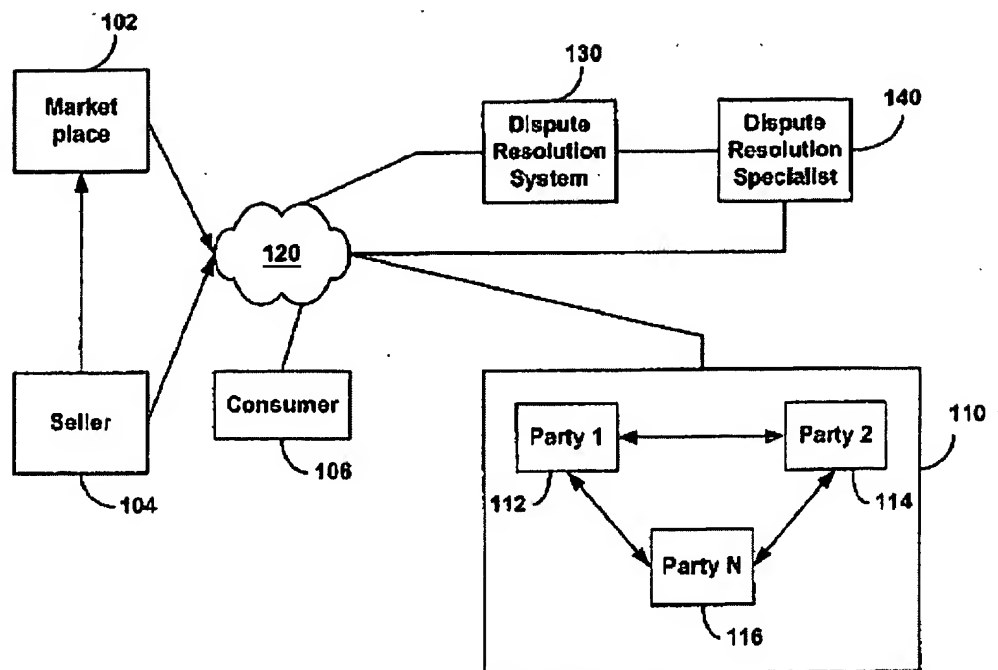
Independent claims 49, 58, 66-73 are directed to various embodiments of systems and methods in which an online marketplace and an online dispute system are integrated to assist buyers and sellers of the marketplace to resolve disputes.

Appellant directs the Board to the elements of independent claim 73 as these elements best illustrate the issues presented by this Appeal. Claim 73 reads as follows:

*A system comprising:  
an online dispute resolution system that executes a dispute resolution process;  
and  
an electronic marketplace system that includes:  
(i) a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers,  
(ii) a database that stores data, and  
(iii) a software object that communicates the data from the database to the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system.*

The elements of claim 73 are described within the present application and illustrated in FIG. 1 and FIG. 2B, and referenced in the description below by way of parentheticals.

FIG. 1 of the present application, reproduced below, illustrates one or more sellers 104 (recited as “a plurality of sellers” in claim 73) that offer their products and/or services to one or more consumers 106 (recited as “a plurality of buyers” in claim 73) at a marketplace 102 (recited as “an electronic marketplace system” in claim 73).



**FIG. 1**

The present application states that, in one embodiment, marketplace 102 is an online marketplace.<sup>1</sup> Specifically, the present application states that marketplace 102 includes a website that provides an online centralized trading place (recited in claim 73 as “a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers”).<sup>2</sup> With respect to this embodiment, FIG. 1 shows a marketplace 102 that provides a centralized trading place separate and distinct from a seller 104 and a consumer 106, and accessible via a computer network 120. In reference to FIG. 1, the present application gives a specific example of an online marketplace as www.eBay.com, which is a well-known website providing a centralized trading place on the Internet.<sup>3</sup> The present claims are drawn to this embodiment where marketplace 120 is a web site that provides a centralized trading place for a plurality of buyers and sellers. Dependent claims are consistent with this context and require that the claimed electronic marketplace include a database for storing transaction data and provide a web-based interface.

<sup>1</sup> Page 11, ll. 5.

<sup>2</sup> Page 11, ll. 5.

<sup>3</sup> Page 11, ll. 11-17.

FIG. 1 also depicts a dispute resolution system 130 (recited as a “dispute resolution system” in claim 73) coupled to marketplace 102 by network 120. As described in detail in the present application, dispute resolution system 130 assists sellers 104 and consumers 106 in resolving disputes, e.g., disputes related to transactions that occur within marketplace 102. FIG. 2B further illustrates certain elements relevant to the claimed embodiments. The present application states that FIG. 2B shows a “second implementation 150” of a dispute resolution system 150 in which remote software objects (recited as “a software object” in claim 73) located within a partner system allow “business partners” to “integrate” with the dispute resolution system.<sup>4</sup> A reproduction of FIG. 2B is shown below:

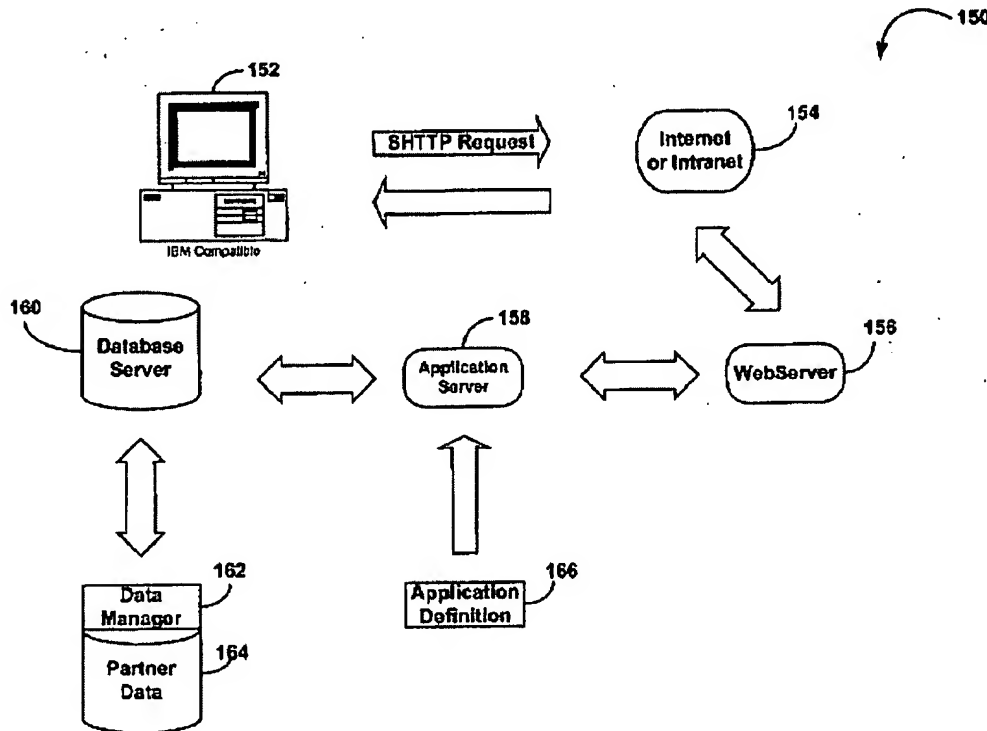


FIG. 2B

The present application states that the embodiment of FIG. 2B allows “specific information” to be shared between the partner system and the online dispute resolution system.<sup>5</sup> With respect to the embodiment of FIG. 2B, the present application provides a specific example in which such functionality may be used to communicate specific information so as to inform the online dispute resolution system

<sup>4</sup>See [0046] stating that FIG. 2B describes a second implementation 150 of the dispute resolution system; See also [0047] stating that the remote software objects allow business partners of the system to **integrate** with the dispute resolution system.

<sup>5</sup> See [0047] stating describing the use of remote software objects to “provide functionality to receive and send specific information to the dispute resolution system.” See also

of relevant transactions within the partner system (recited in claim 73 as “data ... to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system”).<sup>6</sup> The present application also provides an additional example in which the communication functions of FIG. 2B may be used by the partner system to *query* the online dispute resolution system to determine a specific *status* of a marketplace seller 104.<sup>7</sup> In other words, at least this portion of the present application describes embodiments in which transaction data and status information can be communicated between one or more partner databases 164 of FIG. 2B (recited in claim 73 as “an electronic marketplace system that includes ... a database that stores data”) of the electronic marketplace or other electronic partner system and the online dispute resolution system 130.

Appellant’s other independent claims require features similar to claim 73. Independent claim 49, for example, requires an online dispute resolution system electronically coupled to an electronic marketplace, wherein the electronic marketplace stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services. Claim 49 requires that the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data, and that the dispute resolution system utilizes the received portion of the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.

Independent claim 58 is directed to a method comprising providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace. Claim 58 requires the step of electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute, and utilizing the received portion of the transaction data in accordance with a dispute

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<sup>6</sup> See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

<sup>7</sup> See 0047 stating that “[e]xample functionality includes ... allowing partners to query the dispute resolution system data such as the *status* of a specific marketplace seller 104 (emphasis added).



resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

## **GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Appellant submits the following three grounds of rejection to be reviewed on

Appeal:

1. The first ground of rejection to be reviewed on appeal is the rejection of claims 49-73 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.
2. The second ground of rejection to be reviewed on appeal is the rejection of claims 49-61 and 64-73 under 35 U.S.C. 102(e) as being anticipated by Collins et al. (U.S. Publication No. 2002/0007362).
3. The third ground of rejection to be reviewed on appeal is the rejection of claims 62 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Collins.

Appellant submits that the second and third grounds of rejection are rendered moot if the Board reverses the rejection under 35 U.S.C. 112, first paragraph. The Examiner based the second and third grounds for rejection on subject matter first available after Appellant's original priority date, which the Examiner refused to recognize in view of the rejection under 35 U.S.C. 112, first paragraph.

## ARGUMENTS

### The First Ground of Rejection

Appellant's claims 49-73 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

#### *Standard for compliance with the written description requirement*

The first issue for review by the Board is the Examiner's failure to apply the proper standard when rejecting Appellant's claims under 35 U.S.C. 112, first paragraph. For a claim to satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can *reasonably conclude* that the inventor had possession of the claimed invention.<sup>8</sup> It is well established that satisfaction of the written description requirement does not require the presence or absence of literal support.<sup>9</sup> Claim limitations can be satisfied through express, implicit or even inherent disclosure.<sup>10</sup>

The Examiner has committed legal error by improperly disregarding this rule of law. Instead of properly evaluating the disclosure for evidence that the inventor had possession of the claimed invention, the Examiner has required express disclosure, i.e., verbatim language within the specification, for the claim limitations.

In the Office Action mailed July 25, 2005, the Examiner rejected Appellant's claims under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. In a Response mailed November 23, 2005, Appellant respectfully traversed the rejection and identified substantial disclosure within the specification to demonstrate that the specification describes the claimed invention in sufficient detail to permit one skilled in the art to *reasonably conclude* that the inventor had possession of the claimed invention at the time the application was filed.

In the Final Office Action mailed April 4, 2006, the Examiner maintained the rejection. Although the Examiner included boilerplate language that described the

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<sup>8</sup> See, e.g., *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1319, 66 USPQ2d 1429, 1438 (Fed. Cir. 2003); *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d at 1563, 19 USPQ2d at 1116; See also, *In re Kaslo*, 707 F. 2d 1366, 217 USTP 1089 (Fed. Cir. 1983).

<sup>9</sup> *Id.*

<sup>10</sup> See MPEP 2163 Guidelines for the Examination of Patent Applications Under the 35 U.S.C. 112, para. 1, "Written Description" Requirement, pg. 5.

correct standard for adequate written description,<sup>11</sup> the Examiner ignored binding precedent and applied a completely different standard that finds no basis in the law. In particular, the Examiner required express disclosure of every feature set forth in the claims. The Examiner's analysis in support of the rejection under 35 U.S.C. 112, first paragraph are set forth in pages 2-10 of the Final Office Action. Unfortunately, the analysis amounted to a mere pasting of Appellant's claims (pp. 3-7), a list of questions, and a statement that the Examiner failed to identify the claim limitations by way of a text search of the original disclosure (pp. 9, ln. 8). From the limited scope of this analysis, it is clear that it did not conform to the law.

On pages 23 and 24 of the Final Office Action, the Examiner's first addressed Appellant's remarks in the Response dated mailed November 23, 2005 by first stating that she disagreed with the standard necessary to show compliance with the written description requirement. In particular, the Examiner stated:

The Examiner does not agree with the applicant's assertion that a written description must describe the claimed invention in sufficient detail so that one skilled in the art can *reasonably conclude* that the inventor had possession of the claimed invention. (emphasis original).<sup>12</sup>

Importantly, the Examiner herself highlighted the terms "reasonably conclude" to emphasize that she expressly disagreed with this as the applicable standard and, therefore, was not applying it as the standard. The Examiner's unwillingness to apply the proper legal standard, whether she agrees with it or not, constitutes clear legal error. For this reason alone, the rejection must be reversed.

Further statements made by the Examiner indicate that her analysis is grounded on the premise that the claim limitations must be "expressly disclosed" by the present application in order to meet the written description requirement.<sup>13</sup> For example, the Examiner rejected the notion that implicit or inherent disclosure of Appellant's specification can be used to satisfy the written description requirement. The Examiner characterized Appellant's argument as asking the Examiner to rely on implicit or inherent disclosure within the present application to satisfy the written description requirement, but explicitly refused to apply this standard because

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<sup>11</sup> Final Office Action mailed April 4, 2006, page 2 (using language of "reasonably convey").

<sup>12</sup> Id at pp. 24-25.

<sup>13</sup> Id at pg. 24, ll. 7-12 (where the Examiner states "[s]ince the claim limitations are not expressly disclosed, applicant is asking the Examiner to rely on implicit or inherent disclosure to satisfy the

Appellant “does not give the same implicit or inherent consideration to the prior art” relied upon by the Examiner.<sup>14</sup> The Examiner did not seem to appreciate the difference between an issue of written description under 35 U.S.C. 112, first paragraph, and an issue of anticipation under 35 U.S.C. 102. Instead, the Examiner refused to apply the proper standard to show compliance with the written description requirement.

First, MPEP 2163.02 specifically addresses the standard for determining compliance with the written description requirement. In this section, consistent with legal principles, the MPEP states that whenever the issue arises, the fundamental factual inquiry is whether the specification conveys with *reasonable clarity* to those skilled in the art that, as of the filing date sought, applicant was in possession of the invention as now claimed.<sup>15</sup> MPEP 2163, heading 1, states that a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can *reasonably conclude* that the inventor had possession of the claimed invention. The Examiner’s disregard for this standard, relying instead on a legally unsupported and requirement of express disclosure, is reversible legal error.

Second, the Examiner also committed legal error by refusing to consider implicit or inherent disclosures of the present application to satisfy the written description requirement. This is, in fact, the legal standard. MPEP 2163.03 expressly states that the subject matter of the claim need not be described literally (i.e., using the same terms or in haec verba) in order for the disclosure to satisfy the description requirement.

Third, the Examiner’s apparent justification for her refusal to consider implicit or inherent of Appellant’s disclosure due to the prior art is erroneous.<sup>16</sup> In this case, the Examiner has cited prior art filed after Appellant’s priority date of February 15, 2000, but which claims priority to three U.S. provisional applications filed prior to the priority date of the present application. Instead of applying the proper standard to determine Appellant’s compliance with the written description, the Examiner has disregarded this standard, relying instead on a legally unsupported requirement of

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written description requirement ... [but this will not be considered because], applicant does not give the same implicit or inherent consideration to the prior art.”)(emphasis added).

<sup>14</sup> Id at pg. 24, ll. 7-12.

<sup>15</sup> MPEP 2163.02 (emphasis added).

express disclosure, in order to reject Appellant's claims in view of prior art first available after Appellant's priority date. However, the breadth of disclosure in the prior art is a completely separate issue and should not impact the analysis of the claimed invention for support. The Examiner cannot require express disclosure by the inventor so as to cite improper prior art. The Examiner is required to apply the correct standard for determining whether the inventors had possession of the claimed invention at the time of filing regardless of the breadth of disclosure of the prior art.<sup>17</sup>

For at least these reasons, the Examiner committed legal error in issuing the rejection under 35 U.S.C. 112, first paragraph, by requiring Appellant's application to expressly disclose the claim elements by using the exact same words. The Examiner's reasoning is founded on the argument that Appellant's claim limitations "are not expressly disclosed," and she expressly declined to consider inherent or implicit disclosures of the present application. The Board should reverse the rejection under 112, first paragraph for this legal error.

#### ***Compliance with the written description requirement***

Upon thorough review of Appellant's specification, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention at the time of filing. Appellant request the Board should reverse the rejection under 112, first paragraph.

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<sup>16</sup> Final Office Action at pg. 24, ll. 7-12.

<sup>17</sup> With respect to the prior art and whether the prior art is entitled to its earliest priority date as established by its provisional documents, the Examiner is required to separately apply the proper standard to determine whether the prior art's provisional documents comply with the requirements of 35 U.S.C. 112 with respect to the cited subject matter. MPEP 2136.03 The Examiner has made no showing whatsoever with respect to the prior art, and refusing to apply the proper stand to Appellant's disclosure is legal error.

### Claim language

To demonstrate compliance with the written description requirement, Appellant directs the Board to the elements of independent claim 73 as these elements best illustrate the issues presented by the Appeal. Independent claim 73 is currently rejected as failing to comply with the written description requirement, as all of the other claims, and reads as follows:

*A system comprising:  
an online dispute resolution system that executes a dispute resolution process;  
and  
an electronic marketplace system that includes:  
(i) a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers,  
(ii) a database that stores data, and  
(iii) a software object that communicates the data from the database to the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system.*

### Examiner's basis for rejection under 35 USC 112, 1<sup>st</sup> paragraph

With respect to claim 73, the Examiner did not dispute that the present application describes an online dispute resolution system that executes a dispute resolution process or an electronic marketplace system that includes a web server that provides a centralized trading place for a plurality of buyers or sellers.

As a basis for the rejection 112, first paragraph, the Examiner first asserted that the specification fails to provide support for the claim elements that the electronic marketplace includes a database that stores data describes transactions performed by the plurality of buyers and sellers with the electronic marketplace system.<sup>18</sup>

Second, the Examiner asserted that the present application does not clearly establish that the online marketplace system actually communicates with the online dispute resolution system.<sup>19</sup> As one example, in forming the basis for the rejection, the Examiner stated “[w]here in the disclosure is there support for an electronic

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<sup>18</sup> Final Office Action at pg. 69 rejecting claim 3 by referring to rejection generally; See pg. 3, item 4 (where the Examiner highlights the claim language “wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace”); See pg. 9 (where the Examiner specifically asks “where is there support for the **database of the electronic marketplace or wherein the electronic marketplace includes a database that stores transaction data that describes transactions with the marketplace**) (emphasis original); See also pg. 29, 4<sup>th</sup> paragraph (where the Examiner takes the position that the specification does not clearly establish that the online marketplace has a database that stores partner transactions).

<sup>19</sup> Id at pg. 29.

marketplace system [having] a web server that provides a centralized trading place for a plurality of buyers and sellers with a database that stores data and a software object that communicates the data from the database to the online dispute resolution system?”<sup>20</sup>

Third, with respect only to independent claims 49 and 68, the Examiner asserted that she was unable to find support that the online marketplace system communicate transaction data to the online dispute resolution system electronically without requiring manual entry of the transaction data.<sup>21</sup>

Evidence showing compliance with the written description requirement

FIG. 1 of the present application, reproduced below, illustrates one or more sellers 104 (recited as “a plurality of sellers” in claim 73) that offer their products and/or services to one or more consumers 106 (recited as “a plurality of buyers” in claim 73) at a marketplace 102 (recited as “an electronic marketplace system” in claim 73). The present application describes an “online marketplace” as “a website or an online centralized trading place.”<sup>22</sup> This provides direct, literal support for the language of claim 73, reciting an “electronic marketplace system that includes a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers.” The present application gives a specific example of an online marketplace as www.eBay.com, which is a well-known centralized electronic trading place.<sup>23</sup> FIG. 1 also depicts a dispute resolution system 130 (recited as a “dispute resolution system” in claim 73) coupled to marketplace 102 by network 120.

FIG. 2B shows a “second implementation” 150 of the invention in which the dispute resolution system integrates with a business partner’s system, such as the online marketplace 102 of FIG. 1. For the convenience of the Board, paragraphs [0046]-[0048] describing FIG. 2B are reproduced in their entirety below:

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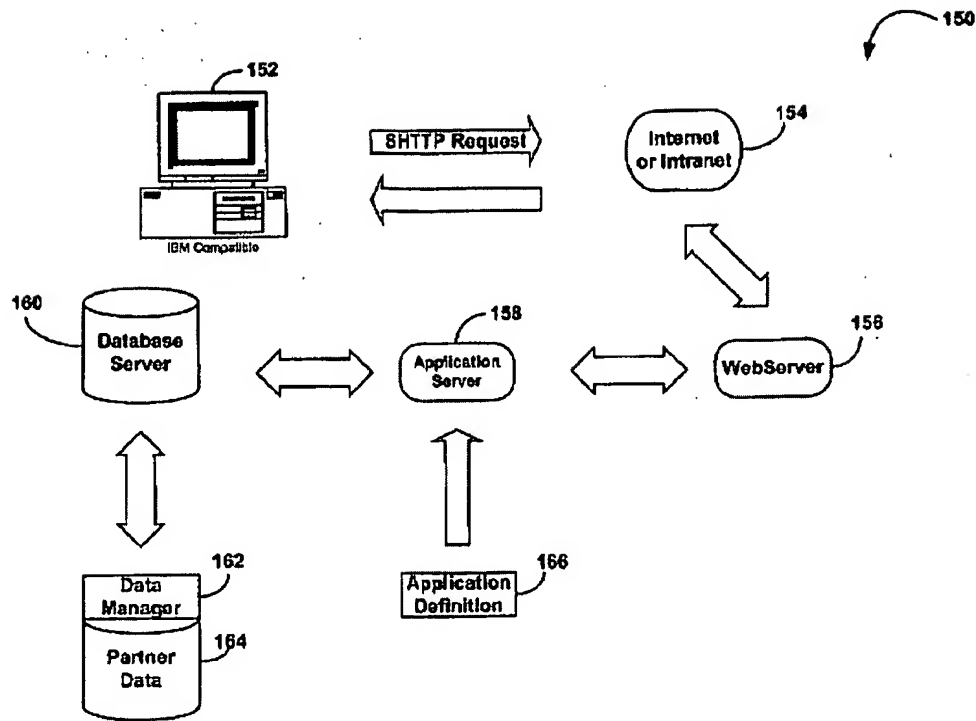
<sup>20</sup> Id at pg. 9, ll. 4-8.

<sup>21</sup> Id at pg. 8, paragraph 4.

<sup>22</sup> Present application at 0039.

<sup>23</sup> Present application at 0040.





**FIG. 2B**

[0046] Referring now to Fig. 2B, a second implementation 150 of the dispute resolution system is shown. In this implementation, a customer (which can be either the seller or the buyer) or a dispute resolution specialist can access data using a web browser on a workstation 152. The data is securely transferred between the workstation 152 to a network 154. The network 154 can be the Internet or can be an intranet. A server 156 communicates with the network 154. The server 156 also communicates with a second server 158, which can be an e-commerce server such as the ColdFusion server, available from Allaire Inc. The server 158 is used as a Web Application Server to present HTML applications. These applications allow customers to file and manage disputes and dispute resolution specialists to manage cases over the Internet.

[0047] The server 158 receives data from a set of remote objects that reside in the partner's system 166. The remote objects, which can be enterprise Java Beans, are provided to allow business partners of the system to integrate with the dispute resolution system. Both DCOM objects and Enterprise Java Beans models can be used. These objects provide functionality to receive and send specific information to the dispute resolution system 130. The objects will transparently deal with communication issues including server unavailability and performance. Example functionality includes informing the dispute resolution system 130 of relevant partner transactions and allowing partners to query the dispute resolution system data such as the status of a specific marketplace seller 104.

[0048] The server 158 in turn communicates with a structured query language (SQL) server 160. The SQL server 160 also communicates with a data manager 162. The data manager 162 in turn communicates with one or more partner databases 164. Partners integrate with the system, by exposing

relevant functionality on their respective websites, for example, allowing customers to dispute a transaction. This integration is achieved by a predefined set of URLs that a partner embeds in the partner's HTML application.

Paragraph [0046] and FIG. 2B describe how a buyer or a seller can use a web browser and workstation 152 to file and manage disputes. Paragraph [0047] then describes functionality by which server 158 is capable of receiving data from a set of remote objects that reside within a partner's system 166. In paragraph [0047], the present application expressly states that server 158 is capable of receiving data from a set of remote objects (recited in claim 73 as the electronic marketplace having "a software object") that reside in the partner's system 166. Paragraph [0047] states that example functionality includes the remote software objects as "informing the dispute resolution system 130 of relevant partner transactions." Paragraph [0047] provides the specific example of the remote software objects sending and receiving information to the online dispute resolution system to inform the dispute resolution system of relevant partner transaction (recited in claim 73 as "inform[ing] the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system").<sup>24</sup> Paragraph [0047] literally uses the term "partner transactions" when illustrating an example of communication with respect to FIG. 2 between a partner system and the online dispute resolution system. FIG. 2, shown above, shows a data manager 162 and a bidirectional arrow between database server 160 of the online dispute resolution system 150 and the partner database 164.

Paragraph [0048] describes a data manager 162 within the online dispute resolution system 150 in communication with one or more partner databases 164. Paragraph [0048] concludes by stating that the software objects and data manager 162 thus allow partner systems to "integrate" with the online dispute resolution system, including exposing relevant functionality of the online dispute resolution system from "their respective websites."

In view of the Examiner's statements, it appears that the entire basis for the rejection under rejection 112, first paragraph, is the Examiner's misinterpretation of

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<sup>24</sup> See 0047 stating that "[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*" (emphasis added).

FIG. 2B and the disclosure presented above. In particular, the Examiner appears to have concluded that the described “partner system” refers to individual buyers or sellers. Based on this incorrect interpretation, the Examiner concluded that the present application fails to provide support for the claim elements set forth above. This position is incorrect, and the rejection 112, first paragraph should be reversed for at least the following reasons.

First, the present application states that the embodiment described in paragraphs 0046-0048 and FIG. 2B allow a “partner system” to “integrate” the functionality of the online dispute resolution system with their “respective website.”<sup>25</sup> Other than online dispute resolution system 150, the *only* other electronic system described by the inventors in the present application as having a website is electronic marketplace 102 of FIG. 1 that provides a website for hosting a centralized trading place for buyers and sellers.<sup>26</sup> Further, paragraph [0048] states that, by way of integration with the partner website, “customers” of that partner system may dispute a transaction. The term “customers” is defined in paragraph [0046] to include “buyers and sellers.” Thus, the literal language of the present application makes clear that the inventors contemplated that the partner system includes a website with which the online dispute resolution system can be integrated, and that the partner system support customers that are buyers and sellers. This provides strong, undeniable evidence that the inventors contemplated the electronic marketplace of FIG. 1 and its website as an example of the partner system described in FIG. 2B.

As further evidence, with respect to FIG. 2B, paragraphs [0047-0048] expressly refer to the partner system as having a partner database 164 that stores partner data 164. Paragraphs [0047, 0048] provide an example in which data communicated from the partner system by way of data manager 162 relate to “partner transactions” for customers, which are described in [0046] as both buyers and sellers. The *only* electronic system described in the present application prior to FIG. 2B that would store transaction data for both buyers and sellers is the electronic marketplace 102 of FIG. 1. This provides further evidence that the inventors considered the electronic marketplace of FIG. 1 as an example partner system described in FIG. 2B.

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<sup>25</sup> Present application, paragraph [0048].

<sup>26</sup> Id at [0039].

Further, literally, the last sentence of paragraph 47 (which is describing FIG. 2B) states “example functionality includes...allowing partners to query the dispute resolution system data such as the status of a specific marketplace seller 104.” This is supportive in multiple ways. First the sentence refers back to a “seller 104” shown in FIG. 1 as a customer of the marketplace system 102. Secondly, the term “marketplace” is explicitly used in the sentence **interchangeably** with “partner,” i.e., that the partner system queries a “**marketplace** seller” and not simply a “**partner** seller.” This evidence strongly indicates that inventors contemplated that, in at least in certain embodiments, the electronic marketplace 102 and its website described in FIG. 1 is an example of a partner system that may be integrated with the online dispute resolution system as shown in FIG. 2B.

The evidence set forth above, and in further view of the totality of the description within the present application, makes very clear, either explicitly or by implication, that the inventors viewed electronic marketplace 102 of FIG. 1 as at least an example of a partner system with which the online dispute resolution could be integrated, as described with respect to FIG. 2B. Moreover, this evidence makes clear that the partner system and the online dispute resolution systematically interact to share data related to transactions within the marketplace. Further, when the disclosure is properly viewed, it is clear that the partner system is not an individual buyer or seller, as apparently assumed by the Examiner. Such an assumption would be contextually inconsistent with much of the evidence set forth above which makes clear the inventors contemplated the partner system as providing a website and database that can integrated with the online dispute resolution system such that customers (individual buyers and sellers) can interact with that partner system to dispute transactions.

In view of at least the evidence identified above, it is clear that one of ordinary skill in the art of electronic marketplaces would have reasonably concluded that the inventors contemplated electronic marketplace 102 of FIG. 1 as an example partner system. Therefore, it becomes abundantly clear that the present application offers sufficient support for the claim elements questions by the Examiner.

With respect to the Examiner’s assertion that the specification fails to provide support for an electronic marketplace including a database that stores data describing transactions performed by the plurality of buyers and sellers within the electronic

marketplace system, paragraph [0048] and FIG. 2 expressly describe a partner system as having “partner databases 164” (recited in claim 73 as “a database that stores data”). The term “partner database” is literally used within the present application. FIG. 2B even shows a database storing partner data 164. Paragraphs [0047, 0048] describes the data as related to “partner transactions” for “customers,” which is defined to include “buyers and sellers” in paragraph [0046]. Having established that one of ordinary skill would reasonably conclude that the inventors contemplated at least one embodiment in which the online marketplace 102 was a “partner system,” the disclosure clearly supports describing the partner system as having a database that stores data describing transactions performed by the plurality of buyers and sellers, as required by independent claim 73.

With respect to the Examiner’s assertion that she was unable to find support for an online marketplace system that communicates with the online dispute resolution system, paragraph [0047] states that server 158 (FIG. 2 above) receives data from a set of objects” (recited in claim 73 as the electronic marketplace having “a software object”) that “reside in the partner’s system 166.” Moreover, paragraph [0048] describes a data manager 162 software object within the online dispute resolution system 150 in communication with one or more partner databases 164. Thus, one of ordinary skill would reasonably conclude that the inventors were in possession of at least one embodiment in which a partner system includes a software object that communicates the data with the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system, as required by claim 73.

With respect to the Examiner’s assertion that she was unable to find support for online dispute resolution system that electronically receives the transaction data from the electronic marketplace, paragraph [0047] further states that example functionality includes the remote software objects as “informing the dispute resolution system 130 of relevant partner transactions.” Paragraph [0047] literally uses the term “partner transactions” when illustrating an example of communication with respect to FIG. 2 between a partner system and the online dispute resolution system. FIG. 2, shown above, literally shows a data manager 162 and a bidirectional arrow between database server 160 of the online dispute resolution system 150 and the partner

database 164. Paragraph [0047] provides a specific example of the remote software objects sending and receiving information to the online dispute resolution system to **inform the dispute resolution system of relevant partner transactions** (recited in claim 73 as “inform[ing] the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system”).<sup>27</sup> FIG. 2 illustrates an example of data communication between the database 160 of the dispute resolution system and partner database 164, and paragraph [0047] specifically provides an example of such communication as informing the dispute resolution system 150 of transactions within the partner system. Thus, one of ordinary skill would reasonably conclude that the inventors were in possession of at least one embodiment in which the online dispute resolution system electronically receives transaction data from the electronic marketplace, as required by independent claims 49, 58, 66-69, and 70.

With respect only to independent claims 49 and 68, the Examiner asserted that she was unable to find support that the online marketplace system communicate transaction data to the online dispute resolution system electronically *without requiring manual entry* of the transaction data.<sup>28</sup> As shown above, one of ordinary skill would reasonably conclude that the inventors were in possession of at least one embodiment in which data is communicated between the systems, e.g., from a partner database 164 of a marketplace, as a partner system, to the database 160 of online dispute resolution system 150 to inform the dispute resolution system of transactions by the buyers and sellers. Direct integration or communication between the systems, e.g., by way of database to database communication, as described by the inventors, would, inherently, avoid manual reentry of the communicated data into the online dispute resolution system. Moreover, according to the present application, the remote software objects of the partner system will “transparently deal with communication issues” including server unavailability and performance when communicating data to the database of online dispute resolution system 130.<sup>29</sup> These sections make clear that the software objects *transparently* communicate the partner data from the partner system to the online dispute resolution system 130. Thus, although the specification

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<sup>27</sup> See 0047 stating that “[e]xample functionality includes informing the dispute resolution system 130 of relevant partner *transactions*” (emphasis added).

<sup>28</sup> Id at pg. 8, paragraph 4; Applicant also points out that this limitation is not found within claim 73.

<sup>29</sup> Para. [0047].

does not include the exact words “without manually entering the transaction data into the dispute resolution system,” it is clear that the present inventors contemplated and described certain embodiments of *transparent* electronic transfer of *transactions* from the database 164 of the marketplace 102 to the database 160 of the online dispute resolution system. If indeed manual reentry of transactions were required by online dispute resolution system, contrary to the second embodiment 150 of the present application, then partner database 164 would not be accessed and server 156 would not “receive data” from the database informing the online dispute resolution system 130 of “partner transactions,” as expressly described by the present application.

For at least these reasons, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as recited by independent claim 73. The Board should reverse the rejection of independent claim 73 under 112, first paragraph. Appellant now addresses specific requirements of the other claims 49–72 also rejected by the Examiner.

#### *Independent claims 49 and 58*

With respect to claims 49 and 58, the Examiner first asserted that she was unable to find support for the limitation of “wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace.” The Examiner then asserted that she was unable to find support for the limitation of “electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute.” Finally, the Examiner asserted that she was unable to find support for “utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.”

As set forth above, a person skilled in the art at the time the application was filed would reasonably conclude that the inventor was in possession of the claimed limitation that the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace. Moreover, as also addressed above, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claimed limitation of electronically receiving with the online dispute resolution system at least a portion of

the transaction data from the database of the electronic marketplace in response to initiation of a dispute.

The present application provides numerous examples of dispute resolution system 130 as utilizing data describing the transaction to assist buyers and sellers in resolving the disputes related to those transactions. As one example, FIG. 10 shows “a predictive reasoning process 500” in which the dispute resolution system 130 utilizes data describing a disputed transaction to “assist[] the dispute resolution specialists as well as the parties themselves in deciding a fair resolution of the dispute.”<sup>30</sup> In this example, the specification makes clear that dispute resolution system 130 uses data describing the transaction to search a historical database to identify previous cases with similar facts. Dispute resolution system 130 then retrieves, summarizes and displays the outcomes of the cases similar to the disputed transaction for all parties and the dispute resolution specialist to assist them in resolving the present dispute.

For at least these reasons, a person of ordinary skill in the art would reasonably conclude that Appellant was in possession of the claimed invention as recited by independent claim 49 and 58. The Board should reverse the rejection under 112, first paragraph.

#### *Claim 52*

With respect to claim 52, the Examiner asserted that she was unable to find support for the limitation of “wherein the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace.”

As discussed above, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” At paragraph [0048], the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 of the dispute resolution system 150 that communicates with a data manager 162, which “in turn *communicates with one or more partner databases 164.*” Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to query the dispute resolution system data such as the



status of a specific marketplace seller 104. This makes clear that the software objects executing on the marketplace system or any other partner system may electronically query (via SQL or other format) online dispute resolution system 130, receiving status of specific marketplace sellers 104 in response to that query and updating partner databases 164.

Thus, a person skilled in the art at the time the application was filed would have reasonably concluded that the inventor was in possession of the claim limitation that the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace, as required by claim 52. The Board should reverse the rejection under 112, first paragraph.

#### *Claim 53*

With respect to claim 53, the Examiner asserted that she was unable to find support for the limitation of “a server to service electronic requests issued by a server within the electronic marketplace and to exchange data between the online dispute resolution system and the electronic marketplace.”

As discussed above, paragraph [0048] of the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 of the dispute resolution system 150 that communicates with a data manager 162, which “in turn communicates with one or more partner databases 164.” Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to inform the online dispute resolution system of transactions at the marketplace (thus communicating data from the marketplace 102 to the online dispute resolution system 130) as well as functionality to query the dispute resolution system 130 data and receive data in return. This makes clear that in the described second implementation data can be communicated in *both* directions between marketplace 102 and online dispute resolution system 130, e.g., data from the partner system to the online dispute resolution system 130 to inform the dispute resolution system of transactions, and status data from the online dispute resolution system 130 back to the partner system.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the

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<sup>30</sup> Para. [0085].

online dispute resolution system includes a server (e.g., SQL server 160) to service electronic requests (e.g., queries) issued by a server within the electronic marketplace and to exchange data (e.g., partner data and status information) between the online dispute resolution system and the electronic marketplace, as required by claim 53. The Board should reverse the rejection under 112, first paragraph.

#### *Claim 54*

With respect to claim 54, the Examiner asserted that she was unable to find support for the limitation of “a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace.”

As discussed above, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” Further, paragraph [0048] of the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 (shown as a “database server 160” in FIG. 2B) of the dispute resolution system 150 communicates with a data manager 162, which “in turn communicates with one or more partner databases 164.”

Moreover, the present application makes clear that these software objects executing at the partner system (e.g., the marketplace) interact with data manager 162 to provide functionality to automatically send and receive specific information to and from the dispute resolution system 130. According to the present application, the objects will “transparently deal with communication issues.”<sup>31</sup> This makes clear that the software objects transparently handle communication of the partner data from the partner system to the online dispute resolution system 130.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system include a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace, as required by claim 54. The Board should reverse the rejection under 112, first paragraph.

*Claim 55*

With respect to claim 55, the Examiner asserted that she was unable to find support for the limitation of “wherein the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace.”

As discussed above, paragraph [0048] expressly refers to the partners systems as having “partner databases 164.” At paragraph [0048], the present application describes the second implementation 150 of the online dispute resolution system 130 as having a structured query language (SQL) server 160 of the dispute resolution system 150 that communicates with a data manager 162, which “in turn communicates with one or more partner databases 164.” Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to query the dispute resolution system data such as the status of a specific marketplace seller 104. This makes clear that the software objects executing on the marketplace system or any other partner system may electronically query (via SQL or other format) online dispute resolution system 130 and in return receive status of specific marketplace sellers 104. The present application describes one example of data maintained by the online dispute resolution system as data that relates to the “participation in the dispute resolution process, or can relate to compliance of a participant to the final decision made in the resolution of the dispute.”<sup>32</sup>

It would be apparent to a person skilled in the art that, in view of the totality of Appellant’s teachings, that the data related to the participation of the seller or compliance with a final decision is one type of data that could be automatically communicated to the marketplace via data manager 162, possibly in response to the described queries via the remote software objects executing with the partner’s system. Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace, as

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<sup>31</sup> Para. [0047].

<sup>32</sup> Para. [0011].

required by claim 55. The Board should reverse the rejection under 112, first paragraph.

#### *Claims 51 and 60*

With respect to claims 51 and 60, the Examiner asserted that she was unable to find support for the limitation of an online dispute resolution system that “electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system.”

As one example of support for this limitation, Fig. 4 is a diagram illustrating a process 240 executed by the dispute resolution system whereby a seller can request coverage from the dispute resolution system. Block 240 of FIG. 4 clearly shows the request being initiated at the partner system (see block 240 of FIG. 4), which has been established above as representing electronic marketplace 102 in at least one embodiment. Upon receipt of a request to initiate coverage from the partner system, the online dispute system 130 of Fig. 1 provides the seller with a welcome page 242 wherein the seller can complete the registration process. Blocks 248 and 250 show links for returning the seller to the *partner site* (see, e.g., hyperlinks of “Back to Partner” and “List of Partner Sites”).

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system, as required by claim 60. The Board should reverse the rejection of claims 51 and 60 under 112, first paragraph.

#### *Claims 61 and 62*

With respect to claim 61, the Examiner asserted that she was unable to find support for the limitations of “electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace, and updating the electronic marketplace based on the data received from the dispute resolution system.” With respect to claim 62, the Examiner asserted that she could not find support for controlling the appearance of the visual indicia as a function of

data received from the dispute resolution system for the users in response to resolution of the disputes.

For reasons set forth above, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation of electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace. Support for this element has been demonstrated above.

With respect to the limitation of updating the electronic marketplace based on the data received from the dispute resolution system, the present application describes a registration process in which the online dispute resolution system 130 updates a membership profile database, notifies the applicant of acceptance, and sends electronic data (indicia) to be displayed on the seller's point of sale to indicate membership in the dispute resolution process.<sup>33</sup> Thus, the present application makes clear that the online dispute resolution system is capable of executing a process that sends electronic data to be displayed within a partner system to indicate membership of a particular seller. Moreover, claim 53 as originally filed in the parent application Serial No. 09/504,159, filed February 15, 2000, requires a system, comprising: a network; an electronic marketplace coupled to the network; one or more sellers selling one or more items at the marketplace; one or more buyers consuming one or more items at the marketplace; and a dispute resolution system coupled to the network to resolve a dispute between one or more buyer and seller parties, wherein the dispute resolution system provides a visual indicia to indicate membership in the dispute resolution process. For at least these reasons, a person skilled in the art at the time the application was filed would have recognized that the inventors were in possession of the claim limitation of updating the electronic marketplace based on the data received from the dispute resolution system, as required by claim 61. The Board should reverse the rejection of claims 61 and 62 under 112, first paragraph.

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<sup>33</sup> Para. [0053].

### *Claim 63*

With respect to claim 63, the Examiner appears to assert that she could not support for accessing the dispute resolution system from a website of an electronic marketplace and file disputes *without manually entering the transaction data into the dispute resolution system*. The Board should reverse the rejection of claim 63 under 112, first paragraph for the reasons set forth above with respect to these elements.

### *Claim 64*

With respect to claim 64, the Examiner questioned the claim limitation that the online dispute resolution system receive an electronic query from the marketplace. As explained above, the present application specifically describes a second implementation 150 in which remote software provide within the partner system functionality *to receive and send specific information* to the dispute resolution system 130.<sup>34</sup> Example functionality described by the application includes informing the dispute resolution system 130 of relevant partner transactions and allowing partner systems “*to query*” the dispute resolution system for data such as the status of a specific marketplace seller 104.<sup>35</sup> The Board should reverse the rejection of claim 64 under 112, first paragraph for the reasons set forth above with respect to these elements.

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<sup>34</sup> Paras. [0045]–[0049].

<sup>35</sup> Paras. [0045]–[0049].

### *Claim 65*

With respect to claim 65, the Examiner questioned the claim limitation the electronic marketplace provide a status to the database of the electronic marketplace. Paragraph [0047] describes the remote software objects executing at the partner system (e.g., the marketplace 130 of FIG. 1) as providing functionality to *query* the dispute resolution system data such as the *status of a specific marketplace seller 104*. This makes clear that the inventors contemplated that the software objects executing on a partner system may electronically query (via SQL or other format) online dispute resolution system 130, receive status of specific marketplace sellers 104 and updating partner databases 164.

Thus, a person skilled in the art at the time the application was filed would have recognized that the inventor was in possession of the claim limitation that the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace, as required by claim 65. The Board should reverse the rejection of claim 65 under 112, first paragraph for the reasons set forth above with respect to these elements.

### *Claims 67–72*

With respect to claims 67–72, the Examiner generally asserted that she was unable to find support for the following limitations:

- (1) automatically communicating data from a database of the electronic marketplace to a database of the online dispute resolution system in response to a transaction within the electronic marketplace,
- (2) that the electronic marketplace stores transaction data that describes transactions within the marketplace and communicates the transaction data to the online dispute resolution system without human intervention,
- (3) utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

These limitations have been thoroughly addressed above. For at least the reasons set forth above, a person of ordinary skill in the art would reasonably conclude that

Appellant was in possession of the claimed invention as specified in claims 67-72. The Board should reverse the rejection under 112, first paragraph.

### **The Second and Third Grounds of Rejection**

The second ground of rejection to be reviewed on appeal is the rejection of claims 49-61 and 64-72 under 35 U.S.C. 102(e) as being anticipated by Collins et al. (U.S. Publication No. 2002/0007362). The third ground of rejection to be reviewed on appeal is the rejection of claims 62 and 63 under 35 U.S.C. § 103(a) as being unpatentable over Collins.

The issue for review by the Board is that the Examiner improperly relied on the Collins reference as prior art. For purposes of this appeal, as discussed below, the second and third grounds of rejection are rendered moot if the Board reverses the rejection of Appellant's claims under 35 U.S.C. 112, first paragraph.

The present application is a continuation of and claims priority to Serial No. 09/504,159, filed February 15, 2000. Collins was filed April 28, 2000, which is nearly two months after Appellant's priority date of February 15, 2000, but claims priority to three U.S. provisional applications filed prior to the priority date of the present application.

In the previous responses, Appellant pointed out that subject matter of Collins relied upon by the Examiner is unsupported by the Collins provisionals and, therefore, does not qualify as prior art under 102(e). MPEP 2136.03 states that the 35 U.S.C. 102(e) critical reference date of a U.S. patent or U.S. application publications entitled to the benefit of the filing date of a provisional application under 35 U.S.C. 119(e) is the filing date of the provisional application if the provisional application(s) properly supports the subject matter relied upon to make the rejection is in compliance with 35 U.S.C. 112, first paragraph.

The Collins provisionals describe only a stand-alone complaint-handling system in which all parties directly access the Collins's complaint handling system and manually enter all data describing a situation.<sup>36</sup> The Collins's provisionals provide no

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<sup>36</sup> Collins at [0037]-[0038] (stating that Party A "initiates a negotiation session by connecting with the central server 120 [of the complaint handling system] and providing data to the central server 120 concerning the nature of the situation and the identity of party B." Party B then responds by providing his or her position data to the same system. With respect to the embodiment of Figure 1A, Collins



teaching or suggestion of a system in which any form of data is automatically communicated to an online marketplace system from a marketplace, let alone to inform an online dispute resolution system of transactions within the marketplace.

The features relied upon by the Examiner, namely FIG. 1B and the related description in paragraph [0045], are not taught or even remotely suggested by any of the Collins provisionals that predates Appellant's filing data. In particular, Appellant can find no teaching or mention within the priority documents that would provide a basis for satisfying the requirements of 112, first paragraph, either expressly, implicitly or inherently. Consequently, in accordance with MPEP 2136.03, with respect to the subject matter shown and described with respect to FIG. 1B of the Collins reference does not receive the benefit of the filing dates of the provisionals. This disclosure formed the primary basis for the Examiner's rejection, and thus the rejection of claims 49–61 and 64–72 must be withdrawn.

On this point, the Examiner's only rebuttal was to rely on the 112, first paragraph, rejection of Appellant's claims discussed above. Specifically, the Examiner's asserted that Appellant's pending claims fail to comply with the written description requirement and, therefore, fail to receive the benefit of the priority date of the Appellant's parent application.<sup>37</sup> Based on this reasoning, the Examiner concluded that reliance on Collins is proper.

The Examiner has made *no attempt* to demonstrate that the subject matter of Collins relied upon by the Examiner *is* supported by the earlier filed Collins provisional documents. The Examiner has not made *any* argument that the Collins priority documents satisfy the requirements of 112, first paragraph, either expressly, implicitly or inherently, with respect to the disclosure relied upon in forming the rejections under 35 U.S.C. §§ 102, 103. The Examiner has made no reference whatsoever to the Collins' provisional documents. The Examiner has, in effect, conceded that the portions of Collins relied upon by the Examiner in rejecting the claims under 35 U.S.C. §§ 102, 103 do not constitute prior art with respect to Appellant's priority date, and instead has relied exclusively on the rejection of Appellant's claims under 35 U.S.C. 112, first paragraph. Consequently, the rejections

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describes Parties A and Parties B interacting with the central server 120 by interacting with HTML "templates."

<sup>37</sup> Final Office Action, pg. 40.

under 35 U.S.C. 102, 103 are rendered moot in the event the Board reverses the rejection of Appellant's claims under 35 U.S.C. 112.

**Conclusion of Arguments**

Appellant claims 49-73 comply with the written description requirement. The Examiner's rejection under 35 USC 112, first paragraph, is improper and should be reversed. As this is the Examiner's sole basis for the rejection under 35 USC 102 and 103, these rejections are also improper and the claims should be allowed.

Respectfully submitted,

Date:

By:

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## **APPENDIX: CLAIMS ON APPEAL**

Claims 1-48 (Canceled).

Claim 49 (Previously Presented): A system comprising:

an online dispute resolution system electronically coupled to an electronic marketplace, wherein the electronic marketplace stores transaction data that describes transactions within the electronic marketplace between buyers and sellers of goods or services,

wherein, in response to initiation of a dispute, the online dispute resolution system electronically receives at least a portion of the transaction data stored within the electronic marketplace without requiring manual entry of the transaction data, and

wherein the dispute resolution system utilizes the received portion of the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.

Claim 50 (Previously Presented): The system of claim 49, wherein the online dispute resolution system electronically receives communications from the buyers and sellers of the electronic marketplace to initiate filing of disputes with the online dispute resolution systems for transactions within the electronic marketplace.

Claim 51 (Previously Presented): The system of claim 49, wherein the online dispute resolution system electronically receives requests from the sellers of the marketplace and automatically initiates enrollment of the sellers within the dispute resolution system.

Claim 52 (Previously Presented): The system of claim 49,  
wherein the online dispute resolution system comprises a membership profile database that maintains status information for the sellers and buyers of the marketplace that are members of the online dispute resolution system, and  
wherein the online dispute resolution system electronically communicates the status information to a database of the electronic marketplace.

Claim 53 (Previously Presented): The system of claim 49, wherein the online dispute resolution system further comprises a server to service electronic requests issued by a server within the electronic marketplace and to exchange data between the online dispute resolution system and the electronic marketplace.

Claim 54 (Previously Presented): The system of claim 49, wherein the online dispute resolution system comprises a data manager software application to automatically communicate data between a database of the online dispute resolution system and a database of the electronic marketplace.

Claim 55 (Previously Presented): The system of claim 49,  
wherein the online dispute resolution system electronically communicates rating data from a database of the online dispute resolution system to a database of the electronic marketplace,  
wherein the rating data relates to participation of the buyers and sellers of the marketplace within the online dispute resolution process.

Claim 56 (Previously Presented): The system of claim 55, wherein the online dispute resolution system maintains the rating data based on compliance of the buyers and sellers to final decisions made in the resolution of the disputes.

Claim 57 (Previously Presented): The system of claim 49, wherein the electronic marketplace presents a web-based interface having embedded uniform resource locators that are associated with the dispute resolution system that enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace and automatically initiate the filing of disputes relating to the transactions.

Claim 58 (Previously Presented): A method comprising:

providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace includes a database that stores transaction data that describes transactions within the marketplace;

electronically receiving with the online dispute resolution system at least a portion of the transaction data from the database of the electronic marketplace in response to initiation of a dispute; and

utilizing the received portion of the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

Claim 59 (Previously Presented): The method of claim 58, further comprising:

electronically receiving with the online dispute resolution system communications from the users of the electronic marketplace to initiate filing of disputes; and

initiating the online dispute resolution process in response to the communications.

Claim 60 (Previously Presented): The method of claim 58, further comprising:

electronically receiving with the online dispute resolution system enrollment requests from the sellers of the marketplace; and

automatically initiating enrollment of the sellers within the dispute resolution system in response to the requests.

Claim 61 (Previously Presented): The method of claim 58, further comprising:  
electronically communicating data that relates to the online dispute resolution process to the database of the electronic marketplace, and  
updating the electronic marketplace based on the data received from the dispute resolution system.

Claim 62 (Previously Presented): The method of claim 61, wherein updating the electronic marketplace comprises:  
displaying in the electronic marketplace visual indicia associated with users of the electronic marketplace that participate in the dispute resolution system; and  
controlling the appearance of the visual indicia as a function of data received from the dispute resolution system for the users in response to resolution of the disputes.

Claim 63 (Previously Presented): The method of claim 58, further comprising embedding uniform resource locators associated with the dispute resolution system within a hypertext markup language application for the website of the electronic marketplace to enable the users of the electronic marketplace to automatically access the dispute resolution system from the electronic marketplace and file disputes without manually entering the transaction data into the dispute resolution system.

Claim 64 (Previously Presented): The system of claim 49, wherein the online dispute resolution system receives an electronic query from the marketplace and provides a status of a marketplace member of the marketplace in response to the query.

Claim 65 (Previously Presented): The method of claim 58, further comprising:  
receiving with the online dispute resolution system an electronic query from the electronic marketplace; and  
electronically providing a status associated with one of the users from a database of the online dispute resolution system to the database of the electronic marketplace in response to the query.

Claim 66 (Previously Presented): A system comprising:  
a dispute resolution system electronically coupled to an electronic marketplace for buyers and sellers of goods and services; and  
a software application to automatically communicate transaction data from a database of the electronic marketplace to a database of the dispute resolution system in response to a transaction within the electronic marketplace by a member of the online dispute resolution system,  
wherein the transaction data is associated with one or more transactions within the electronic marketplace, and  
wherein the dispute resolution system utilizes the transaction data in accordance with a dispute resolution process to assist the buyers and sellers in resolving disputes relating to the transactions.

Claim 67 (Previously Presented): A method comprising:  
providing an online dispute resolution system electronically coupled to an electronic marketplace that provides a website by which users buy and sell items, wherein the electronic marketplace stores transaction data that describes transactions within the marketplace;  
automatically communicating the transaction data stored to the online dispute resolution system without human intervention in response to initiation of a dispute; and  
utilizing the transaction data in accordance with a dispute resolution process to assist the users in resolving disputes relating to the transactions within the electronic marketplace.

Claim 68 (Previously Presented): A method comprising:

- storing transaction data in an electronic marketplace, wherein the transaction data describes transactions within the electronic marketplace;

- receiving case information with an online dispute resolution system, wherein the case information describes a dispute related to one of the transactions of the electronic marketplace;

- automatically communicating at least a portion of the transaction data related to the dispute from the electronic marketplace to the online dispute resolution system without manual intervention; and

- executing a dispute resolution process with the online dispute resolution system that utilizes the transaction data from the electronic marketplace and the case information to assist in resolving the dispute.

Claim 69 (Previously Presented): A method comprising:

- storing transaction data in a database of a electronic marketplace, wherein the transaction data describe transactions within the electronic marketplace;

- receiving case information with an online dispute resolution system from one or more parties, wherein the case information describes a dispute related to one of the transactions of the electronic marketplace; and

- executing a dispute resolution process with the online dispute resolution system that receives at least a portion of the transaction data stored from the database of the electronic marketplace without human intervention in response to initiation of the dispute and uses the received portion of the transaction data and the case information from the parties to assist the parties in resolving the dispute.



Claim 70 (Previously Presented): A system comprising:  
an online dispute resolution system that presents an interface for receiving case information from one or more parties; and  
an electronic marketplace system that includes:  
a database that stores transaction data that describe transactions, and  
a software object that automatically communicates the transaction data from the database to the online dispute resolution system when transactions within the electronic marketplace are performed by members of the online dispute resolution system,  
wherein the online dispute resolution system executes a dispute resolution process that utilizes the transaction data and the dispute information to assist the parties in resolving the dispute.

Claim 71 (Previously Presented): A system comprising:  
an online dispute resolution system having a database of case information for a dispute; and  
an electronic marketplace system that includes:  
a database that stores transaction data that describe transactions for buyers and sellers,  
a software object executing within the electronic marketplace system that automatically communicates the transaction data from the database to the online dispute resolution system without human intervention in response to initiation of a dispute, and  
a software object executing within the electronic marketplace system that queries the database of the online dispute resolution system for status for at least one user of the electronic marketplace system.

Claim 72 (Previously Presented): A system comprising:  
a server that provides an electronic marketplace system;  
a plurality of client computers by which buyers and sellers interact with the electronic marketplace system; and  
an online dispute resolution system having at least one server that communicates with a database of the electronic marketplace system without human intervention in response to initiation of a dispute.

Claim 73 (Previously Presented): A system comprising:  
an online dispute resolution system that executes a dispute resolution process;  
and  
an electronic marketplace system that includes:  
(i) a web server that provides a centralized trading place for a plurality of buyers and a plurality of sellers,  
(ii) a database that stores data, and  
(iii) a software object that communicates the data from the database to the online dispute resolution system to inform the online dispute resolution system of transactions performed by the plurality of buyers and the plurality of sellers within the electronic marketplace system.